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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,450	07/27/2001	Jon C. Pergande	WG0096	8745

7590

01/20/2004

Terence P. O' Brien  
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Chicago, IL 60631

EXAMINER
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DUONG, THANH P

ART UNIT	PAPER NUMBER
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3711

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DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/916,450	PERGANDE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Tom P Duong	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 44-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 44-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-18 and 44-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamada et al. (6,086,485) in view of Vincent et al. (6,592,468). Regarding claims 1, 2, and 6, Hamada discloses a golf club head comprising: a striking face 13 including a rearwardly sloped front side and a rear side, a sole portion 11 extending from the lower region of the rear side and a hole 17 or recess extending into the sole portion (Figure 4). Hamada also discusses an alternative embodiment as shown in Figure 6 where a filling portion 21 having substance of small specific gravity can be filled in the hollow portion 19 or hole 17. The addition of the filling portion in the head allows the center of gravity to be shifted to the rearward end and such configuration eliminates undesirable deflection of shots (Col. 6, lines 46-55). Hamada does not disclose the specific filling material as being a resilient insert. Vincent discloses that the substrate 71 (insert) have sufficient hardness and elasticity to dissipate energy (Col. 7, lines 49-60). In addition, it would have been obvious in view of Vincent to one having ordinary skill in the art to optimize the insert hardness to maximize dissipation of

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energy. Thus, it would have been obvious and desirable in view of Vincent to one having ordinary skill in the art to substitute the substrate of Vincent in lieu of the filing portion of Hamada in order to control the center of gravity and dissipate energy. Regarding claims 3, 4, 7, and 10, Vincent teaches a resilient insert assembly forming of a sleeve 90 positioned proximate cartridge 80 (Figs. 7-7 and Col. 8, lines 58-65), which constitutes a first and second insert. Regarding claim 5, Vincent discloses the first insert, cartridge material made of a metal substrate filled with polymeric material (Col. 3, lines 15-22) and the second insert, substrate made of polymeric material, which has different hardness than the cartridge. Regarding claims 8 and 9, the forwardly projection and the rearwardly indentation of the first and second inserts in the claimed invention are obvious design features to facilitate attachment of the two inserts and such configuration is within the level of ordinary skill in the art. Regarding claim 11, Vincent discloses the insert material of the claimed invention (Col. 7, lines 49-50). Regarding claim 12, it is conventional to provide a cap or cover plate and it would have been obvious to do so here in order to provide indentation graphics or manufacturer logos in the cap. Claims 13-18 and 44-50 recite limitations similar to claims 1-12, above; thus, claims 13-18 and 44-50 are rejected for the same reasons as described above.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-18 and 44-50 have been considered but are moot in view of the new ground(s) of rejection.

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**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

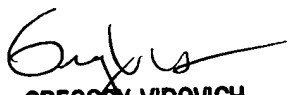
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P Duong whose telephone number is (703) 305-4559. The examiner can normally be reached on 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (703) 308-1513. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Tom Duong

  
GREGORY VIDOVICH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700